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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,574	01/16/2004	Czeslaw Zubowicz	1387-6	7981
23869	7590	11/15/2007		
HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791			EXAMINER CHIN, RICKY	
			ART UNIT 4157	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/759,574	<b>Applicant(s)</b> ZUBOWICZ, CZESLAW	
	<b>Examiner</b> Ricky Chin	<b>Art Unit</b> 4157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims (1,7-8,10,and 13-14) rejected under 35 U.S.C. 102(b) as being anticipated by Robbins, US 2002/0029386.

Regarding claim 1, Robbins discloses a method of automatic control of operation of a digital television decoder comprising switching-on the digital television decoder (See [0051]-[0058], wherein switching-on is an inherent function of automatically recording); switching the digital television decoder to an active mode when a program on the list of programs is currently available; and switching the digital television decoder to a sleep mode when no program located on the list of programs is currently available. (See [0061]-[0062], in which the receiver may remain in sleep mode until a predetermined ID code is detected, wherein the receiver tunes to the data stream carrying the predetermined ID code and is automatically changed to a fully operational mode).

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Regarding claim 7, the method of automatic control of operation of the digital television decoder according to claim 1, further comprising generating an information signal when a new program on the list of programs starts.

Robbins discloses of an automatic reminder system that will detect, extract, and store an ID code that is broadcast with the program that is currently playing, wherein the ID code corresponds to the program that is broadcast. (See [0042]) Furthermore, Robbins further discloses that after activating the automatic reminder system, when the program is broadcast, an ID code transmitted with the broadcast is detected which may sound an alert. (See [0042]).

Regarding claim 8, the method of automatic control of operation of the digital television decoder according to claim 7, wherein the information signal is a specific sound or a verbal announcement.

See claim 7.

Regarding claim 10, the method of automatic control of operation of the digital television decoder according to claim 1, wherein when the decoder is in the sleep mode, no program may be watched.

Robbins explicitly states that with a receiver operating in a sleep mode, the receiver may be dormant, i.e. not playing the data from the received data streams for a user, until a predetermined ID code is detected (See [0062]). The receiver may also remain in sleep mode until the user changes the mode to operational.

Regarding claim 13, the method of automatic control of operation of the digital television decoder according to claim 10, wherein when the decoder is in the sleep mode and a new program from the list is to be broadcasted, an information about the program is displayed in a specific time prior to the beginning of the program.

Robbins discloses that the system may display a message on the television system when the program time arrives. Since the system can compile information into a database upon detection of the ID code, the message displayed can display information pertinent to the program. (See [0038]). Furthermore, Robbins indicates that an automatic reminder system could detect and store an ID code that will automatically tune the receiver to a specific data streams at a specific time. (See [0040]).

Regarding claim 14, the method of automatic control of operation of the digital television decoder according to claim 13, wherein when the information related to a program is displayed, the user has a possibility of canceling watching the program, which results in not switching to the active mode when the program starts.

Robbins discloses of a deactivation system that would prevent the receiver from automatically tuning to a data stream upon detection of an ID code. The system may also have a universal deactivation for all ID codes or for specific ID codes. (See [0173]).

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***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims (2-6,9,and 11-12) rejected under 35 U.S.C. 103(a) as being unpatentable over Robbins, US 2002/0029386 in view of Ellis et al, US 2003/0020744.

Regarding claim 2, Robbin fails to teach the method of automatic control of operation of the digital television decoder, wherein the list of programs is created by a user.

Ellis clearly illustrates that a user may create a list of programs through the use of expressions (See [0009]). Therefore, the combination of the teachings of Robbins and Ellis would have rendered the above claim obvious to one of ordinary skill in the art.

Regarding claim 3, Robbins fails to teach the method of automatic control of operation of the digital television decoder, wherein the list of programs is associated with a specific topic.

Ellis clearly states that the user may construct Boolean expression by selecting criteria such as attribute types, attributes, logical operators, and sorting criteria and further gives an example of such an expression. (See [0078]-[0080]). Therefore, the

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combination of the teachings of Robbins and Ellis would have rendered the above claim obvious to one of ordinary skill in the art.

Regarding claim 4, Robbins fails to teach the method of automatic control of operation of the digital television decoder, wherein the list of programs is created by a well-known person.

Ellis uses the actor Bruce Willis as an example of an expression created by a user. (See [0079]). Therefore, the combination of the teachings of Robbins and Ellis would have rendered the above claim obvious to one of ordinary skill in the art.

Regarding claim 5, Robbins fails to teach the method of automatic control of operation of the digital television decoder, wherein the list of programs is created by an operator and chosen by a user.

There is nothing to prevent a user from being an operator or an operator from being a user. Therefore, in the example Ellis illustrates in [0078]-[0080] the user may also be the operator.

Regarding claim 6, Robbins fails to teach the method of automatic control of operation of the digital television decoder; wherein the list of programs set by the operator is subject list or associated with names of well-known people.

See claim 5. Furthermore, the example Ellis illustrates in [0078]-[0080] indicates an expression for all action programs that have the actor Bruce Willis. Therefore, the

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combination of the teachings of Robbins and Ellis would have rendered the above claim obvious to one of ordinary skill in the art.

Regarding claim 9, Robbins fails to teach the method of automatic control of operation of the digital television decoder, wherein when the decoder is in the active mode, the user may only watch programs that are available on the list.

Ellis teaches of a parental blocking system in which one could block a user from watching programs of a certain criteria. (See [0105] – [0106]). These Programs would be 'locked' and only programs listed without the 'lock' tag could be viewed. Therefore, the combination of the teachings of Robbins and Ellis would have rendered the above claim obvious to one of ordinary skill in the art.

Regarding claim 11, Robbins fails to teach the method of automatic control of operation of the digital television decoder, wherein when the decoder is in the sleep mode and the user requests to watch a program, information about the next available program is displayed.

See claim 10. Furthermore, Ellis discloses a system in which in the process of requesting to watch a program, which could be via the guide display, information such as channel and time about the next available program may be displayed. (See Fig. 7). Therefore, the combination of the teachings of Robbins and Ellis would have rendered the above claim obvious to one of ordinary skill in the art.



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Regarding claim 12, Robbins fails to teach the method of automatic control of operation of the digital television decoder, wherein when the decoder is in the active mode and a new program on the list becomes available, an audio and/or a video information is generated.

See claims 7 and 9. The combination of the teachings of Robbins and Ellis would have rendered the above claim obvious to one of ordinary skill in the art.

### **Contact**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricky Chin whose telephone number is 571-270-3753. The examiner can normally be reached on M-F 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on 571-272-7332. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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